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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,490	07/22/2002	Soojin Kim	9766-US-212	2915

31561 7590 11/05/2003

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE
7 FLOOR-1, NO. 100
ROOSEVELT ROAD, SECTION 2
TAIPEI, 100
TAIWAN

EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/064,490	KIM, SOOJIN	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) *9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Applicant's election of Group I, claims 1-8 in the response to restriction requirement received on 09/25/2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The porous layer made of an open-cell foam is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 4, the unit of the specific gravity is missing. This renders the claim indefinite.

In claim 7, line 3, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Objections

6. Claims 5 and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 5 depends from another multiple dependent claim 4. See MPEP § 608.01(n). Accordingly, the claim 5 is not been further treated on the merits.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-232174. JP'174 teaches each and every element of the presently claimed subject matter. The artificial leather comprises a woven base 1, a porous layer 2 and a film layer 5 filled only in concavities formed on the porous layer, a transfer paper 9 having a convexo-concave shape reverse to a leather-like convexo-concave surface (abstract, [0016], [0018], figures 1-4). It is the examiner's position that JP'174 anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasman et al (US 4,017,656) in view of Katabe et al (US 4,515,852). Lasman teaches an imitation leather material having a layer construction as follows: imitation leather-like surface 24, thin urethane skin 12, high density foam layer 14, lower density foam layer 16, hot melt adhesive layer 18 and a woven fabric base 20 (figure 1). Lasman teaches the process of forming the foam layers (column 6, lines 40-65). Lasman teaches the urethane skin being cast on an embossed transfer sheet in order to impart the embossed designed onto the surface of the urethane skin (column 3, lines 23-30). Lasman does not specifically disclose the emboss pattern having a convexo-concave shape. Katabe, however, teaches such is particular embossed pattern having been used widely on the surface of the leather-like material to decrease slipperiness (column 1, lines 45-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the transfer sheet having a convexo-concave shape reverse to a leather like convexo-cancave surface motivated by the desire to decrease the slipperiness on the surface of the leather-like sheet material.

11. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-232174 in view of Lasman et al (US 4,017,656). JP'174 does not specifically

disclose the process of making the porous layer. Lasman, however, discloses the process of making the porous layer as set forth in the claim (column 6, lines 40-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the process of making the foam layer as taught in Lasman because such is known in the art and Lasman provides the necessary detail to practice the invention of JP'174.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-232174 as evidenced by Nishibayashi et al (US 3,939,021). JP'174 does not specifically disclose the cell size of the porous layer. Nishibayashi is relied as evidence that teaches a leather-like sheet material comprising an open cell polyurethane foam layer having a cell size within the claimed range (example 1, table 4-continued). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use employ the porous layer having a cell size instantly claimed motivated by the desire to provide the leather-like sheet material having smooth surface and an appearance similar to leather.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lasman et al (US 4,017,656) in view of Katabe et al (US 4,515,852) as evidenced by Nishibayashi et al (US 3,939,021). Lasman does not specifically disclose the cell size of the foam layer. Nishibayashi is relied as evidence that teaches a leather-like sheet material comprising an open cell polyurethane foam layer having a cell size within the claimed range (example 1, table 4-continued). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

use employ the porous layer having a cell size instantly claimed motivated by the desire to provide the leather-like sheet material having smooth surface and an appearance similar to leather.

14. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-232174 as evidenced by Higgs et al (US 3,661,674). JP'174 does not specifically disclose the porous layer being bonded to the woven base by an adhesive applied in the form of spots. Higgs is relied as evidence that teaches a leather-like sheet material comprising a foam layer, a woven base layer being bonded to the foam layer by a polyurethane adhesive applied in the form of spots (column 3, lines 40-45, example VI). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive in the form of spots to bond the porous layer and the woven base together motivated by the desire to control the amount and distribution of the adhesive, further controlling the degree of permeability of the leather-like sheet material.

15. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasman et al (US 4,017,656) in view of Katabe et al (US 4,515,852) as evidenced by Higgs et al (US 3,661,674). Lasman does not specifically disclose the porous layer being bonded to the woven base by an adhesive applied in the form of spots. Higgs is relied on as evidence that teaches a leather-like sheet material comprising a foam layer, and a woven base layer being bonded to the foam layer by a polyurethane adhesive applied in the form of spots (column 3, lines 40-45, example VI). Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to use the adhesive in the form of spots to bond the porous layer and the woven base together motivated by the desire to control the amount and distribution of the adhesive, further controlling the degree of permeability of the leather-like sheet material.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 -10 of U.S. Patent No. 6,114,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of Patent No. 6,114,260 discloses each and every element of the presently claimed subject matter with additional limitations of the foam viscosity and expansion ratio.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426.

The examiner can normally be reached on M,T,Th, F, 8:30-6:00 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~ 1700

Daniel Zirker